



SW = 10619378

Docket Number: P0055-GB01/2543-1-022GB

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT : Steven U. Walkley

SERIAL NO. : P-105,357

EXAMINER : Yvonne R. Abbott

FILED : January 25, 2002

ART UNIT : Unknown

FOR : COMPOUNDS

Certificate of Mailing Under 37 CFR 1.8

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to ASSISTANT COMMISSIONER FOR PATENTS, WASHINGTON, D.C. 20231 on November 22, 2002.

Betty Schultz
(Name of Depositor)

Betty Schultz 11/22/02
(Signature and Date)

**RESUBMITTED PETITION FOR RETROACTIVE LICENSE
UNDER 37 CFR 5.25**

OFFICE OF LICENSING AND REVIEW
ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, DC 20231

Sir:

A Decision was received by the undersigned 15 October 2002 which denied the Petition for Foreign Filing License submitted 5 April 2002, on the basis the Petition was defective due to absence of the following items:

1. A listing of each of the foreign countries in which the unlicensed patent application material was filed,
2. The dates on which the material was filed in each country,
3. A verified statement (oath or declaration) containing:
 - i. An averment that the subject matter in question was not under a secrecy order at the time it was filed abroad, and that it is not currently under a secrecy order,

- ii. A showing that the license has been diligently sought after discovery of the prescribed foreign filing, and
 - iii. An explanation of why the material was filed abroad through error and without deceptive intent without the required license under §5.11 first having been obtained, and
4. The required fee (§1.117(h)).

The Decision is in error as all of the requirements set forth were submitted. Accordingly, the undersigned herein resubmits the Petition which includes the following information:

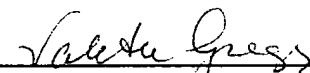
- 1. The unlicensed Patent Application was filed in Great Britain (GB 0100889.5).
- 2. The above-application was filed on 12 January 2001.
- 3. The undersigned states as follows:
 - i. The subject matter in question was not under a secrecy order at the time it was filed abroad, and it is not currently under a secrecy order.
 - ii. I was informed of the potential need for a retroactive foreign filing license on 21 December 2001 from the United Kingdom patent administrator for the applicant of the above identified patent application.
 - iii. The need for a retroactive foreign filing license results from the possibility that one of the inventors of the subject matter of GB 0100889.5 is of American citizenship and some of the work leading to the invention was therefore made in the United States. Steven U. Walkley, of New York, may be an inventor of subject matter contained in GB 0100889.5 and thus, part of the invention was made in the United States. At the time the patent application was filed in Great Britain, a determination of inventorship had not been made. Consequently no one was aware that a possible inventor of subject matter disclosed in GB 0100889.5 included work that was conducted in the United States. The patent application was filed through error and without deceptive intent, without realization of the possibility that the

Docket Number: P0055-GB01/2543-1-022GB

required license under § 5.11 might need to be first obtained because the person in charge of filing the application did not realize that a foreign filing license was needed for an invention made in the United States. Applicants therefore petition for a retroactive foreign filing license out of the possibility that Steven U. Walkley is an inventor of claimed subject matter disclosed in GB 0100889.5.

A Petition for Retroactive License was filed on January 2, 2002 along with a check for \$130.00 for submitting the Petition. A copy is enclosed for your reference.

Respectfully submitted,


Valeta A. Gregg, Ph.D.
Registration No. 35,127

KLAUBER & JACKSON
Continental Plaza
411 Hackensack Avenue
Hackensack, New Jersey 07601
(201) 487-5800

Date: November 22, 2002



Mailed 4/5/02

Serial No P-105,357 File No 2543-1-022 ^{GB} By DAJ/VAG/bs

Title COMPOUNDS

In the Matter of the Application of Walkley

The following was received in the U.S. Patent & Trademark Office on the date stamped hereon: VIA FIRST CLASS MAIL

Resubmitted Petition for Retroactive License

- | | |
|--|--|
| <input checked="" type="checkbox"/> Transmittal Sheet/Cover Ltr. | <input type="checkbox"/> Extension of Time |
| Certified <input checked="" type="checkbox"/> Application For Patent <u>copy</u> | <input type="checkbox"/> Issue Fee Transmittal |
| <input type="checkbox"/> Declaration <input type="checkbox"/> Affidavit | <input type="checkbox"/> Maintenance Fee |
| <input type="checkbox"/> Drawings <input type="checkbox"/> Sheet(s) | <input type="checkbox"/> Appln. TM Registration |
| <input type="checkbox"/> S.E. Verified Statements | <input type="checkbox"/> 8 & 15 Declaration |
| <input type="checkbox"/> Assignment | <input type="checkbox"/> Renewal Application |
| <input checked="" type="checkbox"/> Check for \$ <u>130.00</u> | <input type="checkbox"/> Notice of Appeal |
| <input type="checkbox"/> Letter <input type="checkbox"/> Missing Parts | <input type="checkbox"/> Brief <input type="checkbox"/> Petition |
| <input type="checkbox"/> Priority Document | <input type="checkbox"/> Power of Attorney |
| <input type="checkbox"/> Amendment <input type="checkbox"/> Response | <input type="checkbox"/> _____ |

KLAUBER AND JACKSON

SPECIAL ACCOUNT
411 HACKENSACK AVENUE
HACKENSACK, NJ 07601

13664

55-33/212

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Petition Serial No: P-105,357

Docket No: 2543-1-022

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Joann Rodgers

NP



Docket Number: P0055-GB01/2543-1-022GB

UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT : Steven U. Walkley
SERIAL NO. : P-105,357 EXAMINER : Yvonne R. Abbott
FILED : January 25, 2002 ART UNIT : Unknown
FOR : COMPOUNDS

Certificate of Mailing Under 37 CFR 1.8

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to ASSISTANT COMMISSIONER FOR PATENTS, WASHINGTON, D.C. 20231 on April 5, 2002.

Betty Schultz
(Name of Depositor)

Betty Schultz 4/5/02
(Signature and Date)

**RESUBMITTED PETITION FOR RETROACTIVE LICENSE
UNDER 37 CFR 5.25**

OFFICE OF LICENSING AND REVIEW
ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, DC 20231

Sir:

In response to the Denial of the Petition for Retroactive License dated March 26, 2002, the undersigned herein resubmits the petition for a retroactive license under 35 USC § 184 for Patent Application GB 0100889.5 filed in Great Britain in 12 January 2001, entitled "Compounds" with the required clarifications.

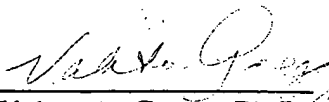
The undersigned verifies as follows:

- i) The subject matter in question was not under a secrecy order at the time it was filed abroad, and it is not currently under a secrecy order.
- ii) I was informed of the potential need for a retroactive foreign filing license on 21 December 2001 from the United Kingdom patent administrator for the applicant of the above identified patent application.

iii) The need for a retroactive foreign filing license results from the possibility that one of the inventors of the subject matter of GB 0100889.5 is of American citizenship and some of the work leading to the invention was therefore made in the United States. Steven U. Walkley, of New York, may be an inventor of subject matter contained in GB 0100889.5 and thus, part of the invention was made in the United States. At the time the patent application was filed in Great Britain, a determination of inventorship had not been made. Consequently no one was aware that a possible inventor of subject matter disclosed in GB 0100889.5 included work that was conducted in the United States. The patent application was filed through error and without deceptive intent, without realization of the possibility that the required license under § 5.11 might need to be first obtained because the person in charge of filing the application did not realize that a foreign filing license was needed for an invention made in the United States. Applicants therefore petition for a retroactive foreign filing license out of the possibility that Steven U. Walkley is an inventor of claimed subject matter disclosed in GB 0100889.5.

The required fee under 37 CFR § 1.17(h) is herein attached.

Respectfully submitted,


Valeta A. Gregg, Ph.D.
Registration No. 35,127

KLAUBER & JACKSON
Continental Plaza
411 Hackensack Avenue
Hackensack, New Jersey 07601
(201) 487-5800

Date: April 5, 2002



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	REQUEST DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
P-105,357	4/16/02	STEVEN U. WALKLEY	2543-1-022P GB

Title: COMPOUNDS

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Art Unit	Paper Number
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Correspondence Address:

VALETA A. GREGG
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HACKENSACK NJ 07601

RECEIVED

DEC 16 2002

KLAUBER & JACKSON

PATENT & TRADEMARK OFFICE
MAILED

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LICENSING & REVIEW

Licensee under 35 U.S.C. 184 is hereby granted to file in any foreign country a patent application and any amendments thereto corresponding to the subject matter of this U.S. application identified above and/or any material accompanying the petition. This license is conditioned upon modification of any applicable secrecy order and is subject to revocation without notice.

License Number: 529,896
Grant Date: 12-Dec-02

This license is granted retroactively to the date(s) and the country(s) indicated on the attached decision.

Approved

for Commissioner of Patents and Trademark

This license empowers the filing, the causation and the authorization of the filing of a foreign application or applications on the subject matter identified above, subsequent forwarding of all duplicate and formal papers and the prosecution of such application or applications.

This license is granted under 37 CFR 5.15(a).

This license is to be retained by the licensee and may be used at anytime on or after the date thereof.
This license is not retroactive unless specifically indicated.

The grant of this license does not in any way lessen the responsibility of the licensee for the security of the subject matter as imposed by any Government contract or the provisions of existing laws relating to espionage and the national security or the export of technical data. Licensees should apprise themselves of current regulations, especially with respect to certain countries, of other agencies, particularly the Department of the Treasury; Office of Munitions Control, Department of State (with respect to Arms, Munitions and Implements of War); the Bureau of Trade Regulation, Office of Export Administration, Department of Commerce; and the Department of Energy.

LICENSE FOR FOREIGN FILING

[Title 35, United States Code (1952) Sections 184, 185, 186]



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

In re: WALKLEY et al. :DECISION ON REQUEST
Petition No.: P-105,357 :UNDER 37 CFR 5.25
Petition Filing Date: January 25, 2002

Title: COMPOUNDS

This is a decision on the petition for retroactive foreign filing license.

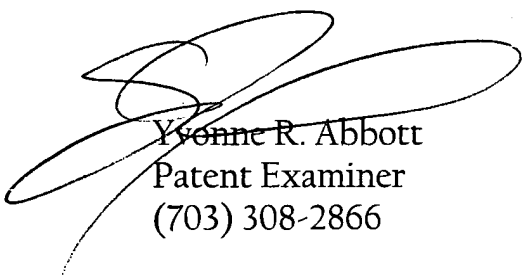
It has been determined that a retroactive license for foreign filing under 35 U.S.C. 184 be granted with respect to the filing(s) listed below. The petition complies with 37 C.F.R. 5.25 in that there is an adequate showing that the subject matter in question was not under secrecy order, that the license was diligently sought, and that the material was filed abroad without the required license under 37 C.F.R. 5.11 through error and without deceptive intent.

Country

Date

Great Britain

January 12, 2001


Yvonne R. Abbott
Patent Examiner
(703) 308-2866